



Exhibits

TTAB

06-21-2002

U.S. Patent & TMO/c/TM Mail Rpt Dt. #71

**UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SAINT-GOBAIN ABRASIVES, INC.,

BOX TTAB

Petitioner,

Cancellation No. 92040569

v.

UNOVA INDUSTRIAL AUTOMATION
SYSTEMS, INC.

Respondent.

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS
CORRESPONDENCE IS BEING DEPOSITED
WITH THE UNITED STATES POSTAL
SERVICE AS FIRST CLASS MAIL IN AN
ENVELOPE ADDRESSED TO: BOX TTAB-
ASSISTANT COMMISSIONER FOR
TRADEMARKS, 2900 CRYSTAL DRIVE,
ARLINGTON, VA 22202-3513 ON JUNE 19,
2002

Dawn Large
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MOTION TO DISMISS

Respondent moves to dismiss the above-identified Petition to Cancel based the following three defenses: 1) equitable defense as a matter of law; 2) laches and acquiescence; and 3) Petitioner's failure to state a claim upon which relief can be granted.

BRIEF IN SUPPORT OF MOTION

BACKGROUND FACTS

Applicant has owned the following U.S. Registrations all relating to a band applied to "the peripheries of abrasive wheels or disks adjacent the rear faces thereof and which is of less width than the thickness of the abrasive wheels or disc." See U.S. Registration 378,705.

TRADEMARK TRIAL AND
APPEAL BOARD
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<u>Miscellaneous Design Mark</u>			
<u>Registration No.</u>	<u>(Peripheral Band)</u>	<u>Date of Registration</u>	<u>Status</u>
378,705	"generic peripheral band"	June 18, 1940	Live
359,768	"yellow in color"	August 30, 1938	Expired 1998
359,766	"blue in color"	August 30, 1938	Expired 1998
374,465	"silver in color"	January 9, 1940	Expired 2000
747,776	"green in color"	April 9, 1963	Live
372,308	"red in color"	October 31, 1939	Live
2,516,176	"blue in color"	December 11, 2001	Live
Application			
No. 75/670,483	"yellow in color"	filed:	Pending

In addition, Respondent owns the accompanying Registration for the accompanying word marks:

<u>Registration No.</u>	<u>Word Mark</u>	<u>Date of Registration</u>	<u>Status</u>
360,043	BLUE-RIM	September 6, 1938	Expired
359,767	RED-RIM	August 30, 1938	Expired
359,769	YELLOW-RIM	August 30, 1938	Expired
374,464	SILVER-RIM	January 9, 1940	Expired 2000
729,024	GREEN-RIM	March 27, 1962	Live
2,454,504	BLUE-RIM	May 29, 2001	Live
2,443,800	RED-RIM	April 17, 2001	Live
2,443,799	YELLOW-RIM	April 17, 2001	Live

All these registrations were for the basic same goods. All the design marks were for the same shape band about the periphery of the goods adjacent a rear face thereof, and having a width less than the thickness of the wheels or discs.

In 1998, several of the above trademarks, namely: U.S. Registration 359,766 for the peripheral band that is blue in color; U.S. Registration 359,768 for the peripheral band that is yellow in color; and the listed word marks lapsed due to non-renewal. Applicant refiled to obtain new registrations for the identical marks and for the same goods. Applicant filed a §2(f) declaration for the present registration indicating that usage was continuous for the past 5 years, i.e., usage never stopped. The Examining Attorney required an amendment for the goods to include "power operated" to more particularly define the goods to today's standards.

The present Petitioner has also filed an opposition to the Registration Application 76/670,483 for the yellow band and this cancellation proceeding against the present registration after 60 years of use and previously existing Federal Registrations for each of these marks.

EQUITABLE DEFENSE

Respondent first supports its motion because of an equitable defense as a matter of law. An equitable defense exists when as a matter of law the moving party cannot be further injured because there already exists an injurious registration, the petition party cannot object to an additional registration that does not add to the injury. See O-M Bread Inc. v. United States Olympic Committee 65 F.3d 933, 36 USPQ 2d 104 (Fed Cir. 1995).

Respondent is the owner of unchallenged incontestable U.S. Registration 378,705 issued on June 19, 1940 for a stripe or band which is applied to the peripheries of the abrasive

wheels or disks adjacent to the rear faces thereof, and which is less width than the width of the wheels or disks as applied to substantially the same goods. (See Exhibit A).

An equitable defense exists here because respondent's present Registration 2,516,176 (Exhibit B) is also for a stripe or band applied to the peripheries of the goods adjacent the rear face thereof, and which is of less width than the thickness of the wheel or disks. In addition, the present registration specifies that the peripheral band is blue in color. The same-shaped band with the same position and same orientation however, creates the same commercial impression as U.S. Registration 378,705 registered on June 19, 1940.

It is well settled that as a matter of law a petitioner's party cannot be further damaged if there exists a previous unchallenged registration for the substantially same mark as applied to substantially the same goods. See Morehouse Manufacturing Corporation v. J. Strickland and Company 56 C.C.P.A. 946, 407 F.2d 881, 160 USPQ 715, 717 (C.C.P.A. 1969). As a matter of law, the petitioner cannot be further damaged within the meaning of the statutes by maintenance or issuance to Respondent of the registration sought "in view of Respondent's ownership of the above noted registration which covers the same mark and encompasses the same good..." See Artichoke Industries Inc. v. Regina Grapes Products Co. 52 C.C.P.A. 1837, 138 USPQ 687, 688 (C.C.P.A., 1963).

In such a case, the Patent Office Trademark Trial and Appeal Board recognizes that the prior registration of the same mark, for closely related goods, precludes the petitioner from prevailing. See Western Leather Goods Company v. Blue Bell, Inc. 178 USPQ 382 (TTAB, 1973). In the case at hand, the marks are virtually identical. Both design marks have the same shaped band about the peripheries of the goods. Both marks have the bands in the same position adjacent the rear face of the abrasive wheel disk. Both marks have the bands in the

same orientation about the peripheries of the wheels or disks. Both marks have bands with less width than the thickness of the wheels or disks. The specificity of the color blue in the present registration does not change the shape, position, orientation, or overall commercial impression of the peripheral stripe or band. The described goods in each registration are abrasive wheels or disks. The present registration more specifically states that these are power operated abrasive wheels or disks due to the change of the United States Patent and Trademark Office descriptive requirements that have occurred over the past 60 years. However, the goods listed in U.S. Registration 378,705 clearly encompass such power operated abrasive wheels or disks of the present Registration. There is no genuine issue of facts here because these facts are of record in the United States Patent and Trademark Office. As such, dismissal is proper.

LACHES AND ACQUIESCENCE

Respondent also supports its motion because of laches and acquiescence. Laches or Acquiescence exists where the moving party has "*a previous opportunity to oppose or cancel registrations of the same or similar goods by the same party who is not applicant.*" See McCarthy on Trademarks and Unfair Competition, 4th Edition Volume 3 §20.38, p. 20-81. Laches and acquiescence exists here because Respondent further has owned previous incontestable U.S. Registration 359,766 issued on August 30, 1938 (Exhibit C) until it was unintentionally not renewed in 1998. Petitioner further has known and has had ample opportunity to cancel the previous mark.

The prior U.S. Registration 359,766 was for the identical mark having the same shape, position, orientation, and color as applied to substantially the same abrasive wheels and abrasive disks. The present application was filed for the identical description of "abrasive

wheels and abrasive disks.” The United States Patent and Trademark Office required the specification of these products be “power operated” due to a change of descriptive requirements that has occurred over the sixty year span. In effect, the products are identical and the mark is identical.

This prior U.S. Registration ‘766 was on the U.S. Federal Register for over sixty (60) years without Petitioner filing any oppositions or cancellations against it.

No other U.S. litigation between the two parties occurred during this sixty year period. Respondent considers the present new registration as merely refile of the previous lapsed U.S. Registration. After a sixty year span of being registered and being in use where this previous Registration 359,766 existed, laches and acquiescence clearly applies.

Respondent has relied on this sixty year period of silence and acquiescence and has built a substantial business in that long expanse of time. Through the sixty years Respondent has filed a §12(c) (now analogous to §8 declaration but to pre-Lanham Act registrations) and §15 declarations on U.S. Registration 359,766, filed a renewal in 1958, and filed a second renewal in 1978. Respondent also refiled the application which matured into the present registration all during the inexcusable silence and acquiescence of Petitioner.

Petitioner has competed against Respondent for many years as set forth in its pleadings ¶ 2 and ¶ 3. Petitioner had actual knowledge of all of Respondent’s previous U.S. registrations at least as early as the year 1967 as evidenced by the previous legal correspondence (Exhibits D, E and F). Exhibit D is a letter from Petitioner’s Canadian Attorney giving notice to the present Respondent about a Canadian Publication of a corresponding Canadian Trademark Application. Exhibit E is a response from Respondent’s informing Petitioner’s attorney of U.S. Registration 378,705. U.S. Registration 378,705 clearly lists the ownership of U.S. Reg.

359,766. Exhibit F shows that Petitioner's legal counsel in Canada acknowledged receipt of such notice and that he gave this information to Petitioner. **He also indicated a colored band would probably pose no problem with his client.** (As a note of explanation, Norton is the predecessor in interest to Petitioner and Landis and Gardner Machine are both predecessors in interest to Respondent). Petitioner sat quiet in the United States for over 35 additional years. Cases showing much shorter time periods have provided a laches and acquiescence defense. See Gerstendorfer Bros. v. United Supply Co. 26 F.2d 564 (D.C. 1928) (15 years); Lightnin Chemical Co. v. Royal Home Products, Inc. 39 C.C.P.A. 1031, 197 F.2nd 668 94 USPQ 178 (C.C.P.A. 1952) (18 years); Willson et al. v. Graphol Products Co., Inc. 38 C.C.P.A. 1030 188 F.2d 498, 89 USPQ 382 (C.C.P.A. 1951) (10 years)

Petitioner has not alleged any recognized causes that negate laches in its Petition. Petitioner has not alleged any 1) a likelihood of confusion; 2) descriptiveness; 3) genericness; 4) fraud; or 5) abandonment that have been recognized to negate laches. Petitioner has not alleged any legitimate cause of action against the particular shape, orientation and position of the peripheral stripe or band. Hence, laches and acquiescence based on a 60 year old registration and its refiling should apply.

INSUFFICIENT PLEADINGS

Petitioner's pleadings do not state a proper cause of action. If we assume all allegations are true, they do not support any attack on the shape, orientation or position of a peripheral band as set forth in previous U.S. Registration 378,705 or the present registration.

Allegation 1: Unova Industrial Automation Systems, Inc. ("Unova") has secured registration of a blue colored stripe or band, applied to the peripheries of the goods adjacent the rear face thereof and which is less width than the thickness of the wheel or disks, as a trademark

for power operated abrasive wheels and abrasive disks, as evidenced by Registration No. 2,516,176. no specific shade of blue is identified, by Pantone number or otherwise.

Allegation 1, if proved true, does not render the Registration 2,516,176 invalid.

No Pantone number is required in the CFR or in any TMEP provision. See TMEP §807.06(a), (b), 808.04, 808.05, and 37 CFR § 2.37.

Allegation 2: Saint-Gobain is and has for many years been engaged in the manufacture and distribution of abrasives, including power operated abrasive wheels and disks, and has built a large and profitable business in connection therewith.

Allegation 2, if proved true, has no bearing on the Registered mark.

Allegation 3: Saint-Gobain has for many years used and uses blue stripes and band of various colors in connection with abrasive products for many years.

Allegation 3, if proven true, has no bearing on the registerability of peripheral stripes or bands. It is noted that allegation 3 does not allege that the Petitioner alleges prior use of a band about the periphery of an abrasive wheel or disc adjacent the rear face thereof and having a width less than the thickness of the disc. Petitioner has not alleged that they use any stripe or band like this.

Allegation 4: Saint-Gobain has used and uses blue stripes, and other colors of stripes, on abrasive wheels in the same and similar manner as Unova.

Allegation 4 does not allege prior use of “stripes” nor does it specify that its “stripes” are in fact about the peripheries of its wheels or disks, or are adjacent the rear face of the disc or have a width less than the thickness of the disc.

Allegation 5: Other companies that make abrasive products, including abrasive wheels and abrasive disks, use various colors for such goods.

Allegation 5, if proven true, has no bearing on this petition. The function of color *per se* is not a sufficient pleading for the case at hand.

Allegation 6: In the abrasives industry, colors used on and in connection with products such as wheels and disks function as an indicator of abrasive grit size and/or application.

Allegation 6 pertains to the use of colors as an indicator of grit size. Allegation 6, if proven true, still does not pertain to the registered mark. The mark is directed to a peripheral band and no such function is alleged toward the peripheral band shape, orientation, or position.

Allegation 7: In the abrasives industry, colors used on and in connection with products function to assist operators to know when a product should be used or should be replaced with another.

Allegation 7 again, is solely directed to color as a function to assist operators. No such allegation is directed to the shape, orientation, or position of the peripheral band.

Allegation 8: In the abrasives industry, colors of stripes across an abrasive wheel designate speed.

Allegation 8 is directed to stripes of color. As such, straight stripes or other vertically oriented stripe or stripes, placed on the flat back of disk, if proven true, are not directed to the shape, position or orientation of the peripheral band as set forth in the instant registration 2,516,176.

Allegation 9: Unova's alleged mark is not distinctive of its goods under Section 2(f) of the Trademark Act because Unova has not had substantially exclusive use of the alleged

mark. The color blue has been used in commercially significant manner by Saint-Gobain and by others in the industry, in connection with abrasive wheels and abrasive disks and like abrasive products.

Allegation 9 is directed only to the color blue which is not the sole aspect of the U.S. Registration. No allegation against §2f is made to the shape, position or orientation of the peripheral band of the registered mark.

Allegation 10: There is a particular shade of blue which has been used extensively by Saint-Gobain itself and through a predecessor in interest and in title which is widely know in the abrasives industry and associated with Saint-Gobain's abrasive products. This blue color is Pantone 300.

Allegation 10 is directed to Petitioner's use of a color blue (Pantone 300). Such use is irrelevant if not in the form of the peripheral band as defined in U.S. Registration 2,516,176. Petitioner never alleges that its use of Pantone 300 is in the form of a peripheral band in the shape or position as shown in U.S. Registration 2,516,176.

Allegation 11: Unova's alleged mark is not distinctive of its goods because Unova uses a variety of colors of stripes on abrasive wheels and abrasive disks, and each of such colors serves a functional purpose, including the blue stripe which is the subject of the registration herein sought to be cancelled.

Allegation 11 is directed to "each of such colors serves a functional purpose." However, petitioner never alleges that the peripheral band serves a functional purpose. If Petitioner cannot allege that the peripheral band is functional, Petitioner should be estopped, from contesting the present mark merely because Respondent adds the color blue to a previous incontestable mark of a peripheral band. If the color blue *per se* is proven functional, it still has no bearing on the rest of Respondent's mark's ability to serve as a trademark.

Allegation 12: Unova's alleged mark is not entitled to registration because Unova's registration covers more than one mark; the registration fails to include a clear and specific description of the shade of color of the alleged mark, and the registration accordingly covers a wide variety of different blue colors, from light blue to navy.

Allegation 12, if proven true, is irrelevant. Respondent has followed all the requirements of CFR and TMEP as to the necessary identification of color. Petitioner is attempting to place a requirement of specificity that plainly does not exist in any of the rules or regulations. The color blue is adequately descriptive of the color taking into account the submitted specimens.

Allegation 13: If Unova is able to maintain its registration for the mark which is the subject of this Petition, Saint-Gobain and other would be damaged insofar as there would be a cloud on their ability to use and to continue to use any blue color for stripes and bands on abrasive wheels and disks for functional purposes.

Allegation 13 is conclusory and without support. This allegation never alleges what peripheral bands it would not be able to use for functional purposes. Petitioner would not be allowed to use a peripheral band that is listed and Registered in U.S. Registration 378,705. No further damage can be incurred because Respondent happens to color its peripheral band to be blue.

Allegation 14: The registration which is the subject of this petition accords a *prima facie* exclusive right to Unova to use the mark. Such registration is a source of damage and injury to Saint-Gobain and its customers and others who use such colored stripes on such abrasive products for reasons of functionality having nothing to do with source identification.

Allegation 14 is again broadly directed to colored stripes that include different shapes, position and orientation than Registrant's peripheral band. Such functional purpose for

these other stripes of different shapes, orientation and position have no pertinence to the present U.S. Registration.

CONCLUSION

In conclusion, the present U.S. Registration 2,516,176 that is the subject of the present petition is the exact same mark as set forth in incontestable U.S. Registration 378,705 for the same goods. The band of the previous incontestable registered mark has been specified to be the color blue in the present registration 2,516,176.

Secondly, Petitioner has waited for at least 35 years to file such a petition and should be precluded on the grounds of laches and acquiescence based on a prior Registration lasting 60 years in duration.

Lastly, the pleadings are so vague and indefinite that even if proven entirely true, they still do not support adequate grounds for cancellation.

In the entire Petition, only the color has been attacked as functional. No permissible grounds for cancellation have been directed to the incontestable features of the present mark.

As such, this petition should be dismissed.

ACCOMPANYING REQUEST TO SUSPEND

Because the above motion, if granted is dispositive of the entire petition, respondent requests that the Board suspend the proceeding pending its disposition of this Motion.

If it is determined that any fees are due with this submission, the Commissioner is hereby authorized and respectfully requested to charge such fee to our deposit account No. 50-0852.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE,
LEARMAN & McCULLOCH, P.C.

Date: June 19, 2002

A handwritten signature in black ink, appearing to read "Steven L. Permut", is written over a horizontal line.


Steven L. Permut
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PROOF OF SERVICE

I hereby certify that a copy of the foregoing MOTION TO DISMISS was served by first class mail, postage pre-paid, on counsel of record for Petitioner at the following addresses on

June 19, 2002:

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